

REMARKS

Applicant has carefully reviewed the Office Action mailed August 10, 2007 and offers the following remarks.

Claims 1-10, 12-21, 23, 25-28, 30, and 32-35 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,237,260 B2 to Yu et al. (hereinafter “Yu”). Applicant respectfully traverses.

For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. The requirement that each and every element be disclosed in the manner claimed is a rigorous standard that the Patent Office has not met in this case.

35 U.S.C. § 102(e) requires that the invention be “...described in (1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant for patent**” (emphasis added). However, Applicant conceived of the present invention prior to the filing date of Yu, and constructively reduced the present invention to practice through the filing of the present application. As such, Yu does not qualify as prior art under § 102(e).

In order to establish that Yu does not qualify as prior art under § 102(e), Applicant herein presents the Declaration of the inventor, Dany Sylvain, under 37 C.F.R. § 1.131, illustrating conception of the present invention prior to the filing date of Yu. Applicant also presents the Declaration of Applicant’s representative, Benjamin S. Withrow, the patent attorney who drafted the present application, to be used in conjunction with the Declaration of the inventor, Dany Sylvain. These declarations show diligence from a time prior to the filing date of Yu through a constructive reduction to practice of the present invention by the filing of the present application.

Based on the Declarations, Applicant asserts that the present invention was conceived of at least as early as February 22, 2003. The inventor, Dany Sylvain, conceived of the Present Invention at least as early as February 22, 2003, the date when Mr. Sylvain completed the Invention Disclosure and submitted it to the Intellectual Property Law Department at Nortel (See Declaration of Dany Sylvain, Paragraphs 3-5, and Appendix A). Appendix A to the Declaration

of Dany Sylvain (hereinafter “Invention Disclosure”) clearly shows conception of each of the limitations of the present invention, as seen below with respect to representative claim 1¹:

A method for facilitating communications between a user element and a protected network resource comprising:

- a) establishing a first tunneling session with the user element via a first access network (see Invention Disclosure, p. 2, “Brief Description of the Invention”; see also Invention Disclosure, p. 3, Figure entitled “Rehoming via VPN tunnel switching”);
 - b) assigning to the user element a first target network protected address for addressing packets intended for the protected network resource and traveling in part over the first tunneling session (see Invention Disclosure, p. 2, “Brief Description of the Invention”);
 - c) establishing a second tunneling session with the user element via a second access network (see Invention Disclosure, p. 2, “Brief Description of the Invention”; see also Invention Disclosure, p. 3, Figure entitled “Rehoming via VPN tunnel switching”); and
 - d) reassigning to the user element the first target network protected address for addressing packets intended for the protected network resource and traveling in part over the second tunneling session (see Invention Disclosure, p. 2, “Brief Description of the Invention”).
- Thus, as seen above, at least as early as February 22, 2003, before the July 8, 2003 filing date of Yu, Mr. Sylvain had conceived of the invention claimed in the present application.

Further, the declarations show that from a date prior to July 8, 2003 (the filing date of Yu), diligent action was taken by Applicant’s representative, Benjamin S. Withrow; the inventor, Mr. Sylvain; and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on October 24, 2003. (See Declaration of Benjamin S. Withrow, Paragraphs 3-14; and Declaration of Dany Sylvain, Paragraphs 5-12). In particular, prior to the July 8, 2003 filing date of Yu, in-house patent attorney for the assignee of the present application reviewed the Invention Disclosure and made a decision to file a patent application seeking protection for the invention disclosed in the Invention Disclosure (see Declaration of Dany Sylvain, paragraph 5). The in-house patent attorney for the assignee sent instructions on April 7, 2003 to Benjamin S. Withrow, registered U.S. patent attorney, Registration No. 40,876, of the law firm of Withrow & Terranova, PLLC,

¹ Independent claim 12 is directed to a tunnel access server, but has basically the same limitations as claim 1, and therefore was also conceived of at least as early as February 22, 2003, as shown in the Invention Disclosure.

instructing him to prepare and file a patent application for the Invention Disclosure (see Declaration of Benjamin S. Withrow, Paragraph 3, and Appendix A; see also Declaration of Dany Sylvain, Paragraph 6 and Appendix B). Mr. Withrow also received instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures prior to April 7, 2003 (see Declaration of Benjamin S. Withrow, Paragraph 5). From the time of receiving the instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures, until about October 24, 2003, Mr. Withrow worked to prepare patent applications for the number of previous Invention Disclosures in essentially a chronological, first-in-first-out fashion (see Declaration of Benjamin S. Withrow, Paragraph 6).

Starting from April 7, 2003, and continuing through October 24, 2003, Mr. Withrow diligently reviewed the Invention Disclosure, spoke with the inventor Dany Sylvain, and diligently worked to prepare a patent application claiming the invention disclosed in the Invention Disclosure (see Declaration of Benjamin S. Withrow, Paragraph 7; see also Declaration of Dany Sylvain, Paragraph 7). The diligent work by Mr. Withrow resulted in a first draft of the Patent Application, which was sent to the inventor on June 5, 2003 (see Declaration of Benjamin S. Withrow, Paragraph 8 and Appendix B; see also Declaration of Dany Sylvain, Paragraph 8 and Appendix C). The inventor, Mr. Sylvain, then reviewed the draft application and provided comments regarding the First Draft to Mr. Withrow on August 21, 2003 (see Declaration of Benjamin S. Withrow, Paragraph 9 and Appendix C; see also Declaration of Dany Sylvain, Paragraph 9). On August 25, 2003, Mr. Withrow revised the Patent Application to incorporate the comments from the inventor and sent a revised Patent Application to in-house counsel at Nortel Networks Limited, the assignee (see Declaration of Benjamin S. Withrow, Paragraph 10 and Appendix C). A copy of the revised Patent Application, the inventor declaration, and the assignment document was also sent on August 25, 2003 to the inventor for his signature (see Declaration of Benjamin S. Withrow, Paragraph 11 and Appendix C; see also Declaration of Dany Sylvain, Paragraph 10). Between August 25, 2003, and October 23, 2003, the in-house counsel for the assignee, Nortel Networks Limited, reviewed the revised Patent Application and provided comments to Mr. Withrow. On October 23, 2003, the in-house counsel for the assignee authorized the filing of the patent application as drafted (see Declaration of Benjamin S. Withrow, paragraph 13). On October 24, 2003, after having received a signed inventor declaration and assignment document from the inventor, and approval from in-house

counsel at Nortel Networks Limited to file the Patent Application, the Patent Application was filed with the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/693,807 (See Declaration of Benjamin S. Withrow, Paragraphs 12-14 and Appendix C; Declaration of Dany Sylvain, Paragraphs 11-12). Thus, from a date prior to July 8, 2003, the filing date of Yu, diligent action was taken by Applicant's representative, Benjamin S. Withrow, the inventor, Mr. Sylvain, and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on October 24, 2003.

The filing date of the Yu reference is July 8, 2003. Based on the declarations and the above facts, Applicant respectfully submits that the date of invention for the present application was prior to July 8, 2003 and that diligent action was taken from a time period prior to July 8, 2003, through the filing of the present application to constructively reduce the invention to practice. Therefore, Yu was not filed before Applicant's present invention. Thus, Yu does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection of claims 1-10, 12-21, 23, 25-28, 30, and 32-35 as being anticipated by Yu is improper and should be withdrawn. Applicant reserves the right to address Yu in the future if required.

Claims 11, 22, 24, 29, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu in view of U.S. Patent No. 7,020,464 B2 to Bahl et al. (hereinafter "Bahl"). Applicant respectfully traverses.

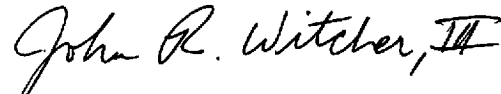
As set forth above, Yu is not prior art under § 102(e) because Applicant conceived of the present invention prior to the filing date of Yu, and constructively reduced the present invention to practice through the filing of the present application. Since Yu is not available as prior art, the rejection of claims 11, 22, 24, 29, and 31 over Yu and Bahl is improper and must be withdrawn. Applicant reserves the right to address Bahl in the future if necessary.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

A handwritten signature in black ink that reads "John R. Witcher, III". The signature is written in a cursive style with a large, stylized "J" and "W".

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